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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/957,044	09/21/2001	Donald L. Todd	26,045-02	3185

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PATENT DEPARTMENT
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EXAMINER

BEKERMANN, MICHAEL

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/957,044	TODD, DONALD L.	
	Examiner	Art Unit	
	Michael Bekerman	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-6, 12, 14, 15, 18-26, 29, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferguson (U.S. Patent No. 5,991,736).** Ferguson teaches a system and method of rewarding users of financial services based on transactions that include the limitations recited in the above claims.

Regarding claims 1-5, 12, 14, 15, 18-21, 23-26, 29, and 30, Ferguson teaches the storing and maintaining of user information identifying a plurality of individuals approved by a financial services provider (Column 7, Lines 66-67 and Column 8, Lines

Art Unit: 3622

1-2), the storing and maintaining of account information including transaction information related to transactions completed (Column 7, Lines 66-67 and Column 8, Lines 1-2), and the storing and maintaining of reward information indicating accumulated reward value (to print a summary reward report, the accumulated rewards must be stored) (Column 13, Lines 56-61) based on transactions completed (Column 8, Lines 2-8).

Ferguson also teaches the monitoring and receiving of transaction information (through an input channel) including transaction amount, an associated account, user information, and reward transfer information (Column 7, Lines 66-67 and Column 8, Lines 1-8). The reward information includes a transferor account, a transferee account, and an amount of reward to be transferred (Column 8, Lines 14-22).

Ferguson further teaches an image generator that produces periodic reports (textual images) based on selected user records, selected account records, and selected reward records (Column 10, Lines 56-67 and Column 11, Lines 1-22).

Regarding claims 6 and 22, Ferguson teaches point-of-transaction terminals as being used to facilitate the receipt of the transaction information (Column 9, Lines 23-28).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3622

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7-11, 13, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson (U.S. Patent No. 5,991,736) in view of Jacobson (U.S. Pub No. 2003/0004876).

Regarding claims 7-11, 13, and 31, Ferguson doesn't go into detail about the old well known method of transaction credit approval and denial. Jacobson teaches storing credit card eligibility status and sending an approval transmission or a denial transmission to a point-of-sale. Should an approval message be sent, the transaction continues as it normally would (as in Ferguson) (Paragraph 0115). It would have been obvious to one having ordinary skill in the art at the time the invention was made to send approval and denial messages to points-of-transaction when credit cards are the method of payment. This will ensure that the merchant will receive adequate payment.

6. Claims 16, 17, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson (U.S. Patent No. 5,991,736) in view of Walker (U.S. Patent No. 6,018,718).

Regarding claims 16 and 27, Ferguson doesn't teach a reward value being generated based on a timing of a transaction. Walker teaches a credit card reward program that requires a target period that the transaction must take place during to receive the reward (Figure 4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply a time limit to the reward. This would cause users to make more transactions in a shorter period of time.

Regarding claims 17 and 28, Ferguson doesn't specify different transaction types, and doesn't teach reward generation based on that type. Walker teaches the targeting of annual purchases at specific merchants to receive a reward (Column 6, Line 28). It would have been obvious to one having ordinary skill in the art at the time the invention was made to target a specific type of transaction for rewards. This would allow certain products/merchants to get more exposure.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art with respect to credit and debit card reward programs:

U.S. Pub No. 2002/0107731 to Teng

U.S. Pub No. 2003/0182247 to Mobed

U.S. Patent No. 6,222,914 to McMullin

U.S. Patent No. 5,689,100 to Carrithers

U.S. Patent No. 5,025,372 to Burton


U.S. Patent No. 6,947,898 to Postrel

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JEFFREY D. CARLSON
PRIMARY EXAMINER